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09/769,392	01/26/2001	Naoyuki Orii		4710

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

BAROT, BHARAT

ART UNIT PAPER NUMBER

2155

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,392

Applicant(s)

ORII ET AL.

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 5, 6, 9, 11, 12, 15, 17-19, 22 and 25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 remain for further examination.

The new grounds of rejection

2. Applicants' amendments and arguments with respect to claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 filed on April 03, 2006 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 15 and 17-19 are rejected under 35 U.S.C. 101 because claim 15 recites "a computer readable medium recording a program..." is non-statutory for at least the reason that is not tangible embodied in a manner so as to be executable. Claim 22 is rejected under 35 U.S.C. 101 because claim 22 recites "a computer program embodied in signals,..." which is intangible media incapable of being touched or perceived absent the tangible medium through which they are conveyed. Further, a signal claim adapted to perform some steps has intrinsic evidence in the spec that applicant intends the medium to cover signals. The current office position is that this type of claim is not statutory. See the Interim Guidelines under the heading "Electro-Magnetic Signals".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 are rejected under 35

U.S.C. 102(e) as being anticipated by Baranowski (U.S. Patent No. 6,813,608).

Baranowski's patent meets all the limitations for claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 recited in the claimed invention.

7. As to claim 3, Baranowski teaches a system for distributing information on a shopping mall to portable terminals of customers (figure 1; and column 4 lines 28-67), comprising: a terminal (base station) located in a store in the shopping mall operative to register in advance first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution (figures 1-3; column 7 line 65 to column 8 line 26); a means for registering in advance preference information

regarding each customer (column 8 lines 22-26; and column 13 line 62 to column 14 line 16); means for perceiving a visit of the shopping mall by a customer; a means for distributing, when the specific area by distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting the shopping mall and for distributing the second information, differing from the first information, to portable terminals of customers not perceived to be visiting the shopping mall (figures 1 and 5; column 8 line 27 to column 10 line 61; and column 13 line 53 to column 15 line 64).

8. As to claim 5, Baranowski teaches that the first information concerns a special sale, and customers are enabled to make an advance booking with a store by responding through the portable terminals (see abstract; column 4 lines 56-67; column 8 lines 27-63; and column 14 lines 17-29).

9. As to claim 6, Baranowski teaches that the first information concerns a degree of congestion at an attraction or a restaurant, and customers are enabled to make an advance booking with the attraction or restaurant by responding through the portable terminals (column 15 lines 1-64).

10. Claims 9, 11-12, 15, 17-18, and 22 represent method, program, and signal that are parallel to the system of claims 3 and 5-6. Claims 9, 11-12, 15, 17-18, and 22 do not teach or define any new limitations above claims 3 and 5-6; therefore, they are rejected for similar reasons.

11. Claim 25 does not teach or define any new limitations above claim 3; therefore, it is rejected for similar reasons. Additionally, Baranowski discloses a server having a processor and teaches that the processor performs the steps of: registering, perceiving, and distributing (figures 1-3; and columns 4-7)

Claim Rejections - 35 USC § 103(a)

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baranowski (U.S. Patent No. 6,813,608).

14. As to claim 19, Baranowski fails to teach the claimed limitation wherein the plurality of grouped storage media is divided into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media.

However, "Official Notice" is taken that the concept and advantages of dividing the program into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Baranowski by dividing the program into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media for improved memory organization and access.

Response to Arguments

15. Applicant's arguments with respect to claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 filed on April 03, 2006 have been fully considered but they are not deemed to be persuasive and deemed to be moot in view of the new grounds of rejection. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at (571) 272-4006.

Bharat Barot
**BHARAT BAROT
PRIMARY EXAMINER**

Patent Examiner Bharat Barot

Art Unit 2155

June 16, 2005